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EXAMINER
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D AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/761,454	<b>Applicant(s)</b> TROP ET AL.	
	<b>Examiner</b> Stephen M. D'Agosta	<b>Art Unit</b> 2683	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 6-21-04 have been fully considered but they are not persuasive:

1. The applicant has overcome the examiner's objection of claim 2 (corrected typo).
2. The applicant argues "Gruchala discloses a CPP paging system but does not describe a system in which a paged subscriber preselects various rules used for charging a page". The examiner disagrees since Gruchala teaches means in which calls/pages can be charged (abstract).

An enhanced Calling Party Pays (CPP) or Paging Party Pays (PPP) system that enables 1) billing of calls originating from traditionally non-billable sources, 2) routing of incoming calls to voicemail if the caller does not wish to incur the additional charges, 3) allowing the caller to complete the call and charge the cellular (or paging) subscriber for additional air-time usage when the caller enters a PIN or security code, also referred to as a billing override code, and 4) allowing the caller to block CPP/PPP charges from being billed to the calling party.

Hence, one skilled can provide them as either predetermined rules the user selects or as rules the user selects real-time as the call/page occurs (which reads on the claim).

3. The applicant argues that "Foladare discloses a system in which a caller and a paged party are connected by a switch but fails to disclose a conferencing system using the processes disclosed herein". The examiner disagrees since he interprets the term "conferencing system" as being a feature provided by the service provider's phone switch (as is well known in the art). Hence, if the user desires a call-conferencing feature, then it is anticipated that the user will pay an extra fee and will have the ability to be connected to one or more parties.

4. The applicant argues that the other art cited does not teach the claimed limitations (ie. Moreover, Foladare fails to disclose a CPP paging system. Neustein is only cited for disclosing a pager with a digital display. However, the other elements missing from Gruchala are not disclosed by this reference. Checco is cited for disclosing a system with analog-to-digital conversions. However, that is not what the claims call for. As discussed above, one feature of the present invention is that it provides for a voice message from a caller to be transcribed by a person into a digital message. No such process is disclosed in Checco). The examiner disagrees since these are provided prior art which is to be combined with Gruchala (eg. in a 103 combination) to arrive at the claimed invention. Hence, they provide features that Gruchala is missing – the combination is valid since they are from the same field of endeavor and solve similar technical problems.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-16** rejected under 35 U.S.C. 103(a) as being unpatentable over Gruchala et al. US 6,263,056 in view of Neustein US 5,473,667 and Foladare et al. US 5,960,064.

As per claims 1 and 6, Gruchala teaches a cellular/paging system (ie. CPP or PPP) for sending a message to a subscriber of the system (title, abstract and figures 1-2) comprising', A pager adapted to receive a page (abstract teaches paging pady pays and figure 2 shows paging system)

A paging server adapted to receive a request for sending said page, said request including information about the caller (C4, L31-58)

A payment server coupled to said paging server and adapted to charge one of said caller and said subscriber in accordance with predetermined rules (C1 , L13-34 and C4, L15 to C5, 15 teaches rules for charging, specifically C4, L45 to C5, L15. Also C3, L10-23).

**But is silent on** to display a message from a caller to a subscriber and rules selected by the subscriber.

The examiner notes that while the applicant teaches paging and payment servers, Gruchala teaches a MSC/SCP/STP systems that performs the functions of these two servers as noted above). Neustein teaches a paging system that provides caller information to the called party's display (C6, L32-43).

**With further regard to claim 6**, Gruchala is silent on automatic establishment of a communication link between subscriber and caller AND a conference switch and when said caller initiates said page request for a return call request from said subscriber. Foladare teaches connection between subscriber and caller via a bridging/signaling unit (abstract and figures 1 and 3a-3c).

Gruchala teaches having the ability to bill calls based on the user's real-time preference. One skilled would also provide means for setting up beforehand how certain calls should be handled/billed (eg. abstract teaches predetermined rules). The (conference) switch taught by Foladare would provide a connection between caller and subscriber.

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that a message is displayed, to provide means for the user to identify the caller.

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As per claim 2, Gruchala teaches claim 1 wherein said payment and paging servers cooperate to deliver said page to said pager only if said payment server determines method of payment for said page (C4, L45 to C5, L15 teaches determination of payment methods AND C3, L10-23).

As per claim 3, Gruchala teaches claim 1 but is silent on further comprising a conference switch responsive to a return call from said subscriber, said conference switch being adapted to establish a communication link between said subscriber and said caller.

Foladare teaches a bridge/signaling unit whereby a caller and called party are connected (abstract and figures 1 and 3a-3c). It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that a conference switch is used to establish a link, to provide means for ease of connection between calling/called parties.

As per claim 4, Gruchala teaches claim 3 wherein said paging server is adapted to charge said one of said subscriber and said caller for said page and said return call (C4, L45 to C5, L15 teaches multiple ways to determine who pays) **but is silent on based on said predetermined rules.**

Gruchala teaches having the ability to bill calls based on the user's real-time preference. One skilled would also provide means for setting up beforehand how certain calls should be handled/billed (eg. abstract teaches predetermined rules).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Gruchala, such that there are predetermined rules, to provide means for the user to setup rules beforehand how certain calls are to be handled (rather than real-time).

As per claim 5, Gruchala teaches claim 1 further comprising a caller identifier that identifies an account associated with said caller, wherein said payment server charges said account for said page (C4, L1-45 to C5, L5 teaches ability to use calling party's account or credit card).

As per claim 7, Gruchala teaches claim 6 but is silent on wherein said conference switch is adapted to establish communication when said caller remains connected after making said page request but is silent on connected to a hold position while waiting for the return call.

Foladare teaches a bridge/signaling unit whereby a caller and called party are connected and that the caller remains connected (abstract and figures 1 and 3a-3c). It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that switch connects calling/called party after page request, to provide for ease of connection between calling/called parties.

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The examiner notes that putting a caller on hold is well known in the art and would be used to "park" a caller while the call is connected and/or while the callee makes a decision as to answer the call or not. Gruchala teaches forwarding the call to voice mail (abstract) which reads on the claim.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Gruchala, such that it is connected to a hold position while waiting for the return to, to provide means for parking the call while the caller waits for a connection.

As per claim 8, Gruchala teaches claim 6 wherein said caller is associated with a caller phone number (C4, L15 to C5, L15 teaches identifying user) but is silent on and wherein said switch is responsive to a number from said subscriber which is different from said caller telephone number.

Neustein teaches a paging system whereby caller profile is identified and the subscriber can determine various numbers by which the called party will respond (C4, L61-67). One skilled in the art would provide for a calling party to be associated with at least one number or more. Hence, a calling party that has access to multiple phones, ie. cell phone, business phone and home phone, can be identified as the same calling Pady.

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that the switch is responsive to a different number for the calling pady, to provide means for one user to be associated with multiple calling numbers for ease of connection between calling/called parties.

As per claim 9, Gruchala teaches claim 8, wherein said switch is responsive to a toll free number whereby said subscriber does not pay for said return call (C4, L15 to C5, L15 discloses identifying calling party information, eg. toll call, as well as if the calling pady can be billed for the return call, C3, L49-52).

As per claim 10, Gruchala teaches claim 9, wherein said pager server is arranged to generate a charge for said page (multiple options exist: abstract teaches CPP/PPP, caller's credit card account can be billed C4, L59 to C5, L4, call billed to called party, C5, L1 1-12) **but is silent on** based on a set of rules determined by the subscriber. The examiner notes that if CPP/PPP is not enabled, the called party is always billed.

Gruchala teaches having the ability to bill calls based on the user's real-time preference. One skilled would also provide means for setting up beforehand how certain calls should be handled/billed (eg. abstract teaches predetermined rules).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Gruchala, such that there are predetermined rules, to provide means for the user to setup rules beforehand how certain calls are to be handled (rather than real-time).

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As per claim 11, Gruchala teaches claim 9, wherein said pager server is adapted to charge the caller for said page (multiple options exist: abstract teaches CPP/PPP, caller's credit card account can be billed C4, L59 to C5, L4).

As per claim 12, Gruchala teaches claim 6, further comprising a payment server coupled to said pager server, said payment server being adapted to generate a charge associated with said page and said return call (abstract teaches PPP and C4, L15 to C5, L15 teaches SCP gathering/performing billing operations) **but is silent on said charge being determined from a set of rules selected by the subscriber.**

Gruchala teaches having the ability to bill calls based on the user's real-time preference. One skilled would also provide means for setting up beforehand how certain calls should be handled/billed (eg. abstract teaches predetermined rules).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Gruchala, such that there are predetermined rules, to provide means for the user to setup rules beforehand how certain calls are to be handled (rather than real-time).

As per claim 13, Gruchala teaches claim 12, wherein said payment server is adapted to identify an account associated with said caller, said charge being sent to said account (C4, L50 to C5, L15 teaches billing calling party).

As per claim 14, Gruchala teaches claim 13, wherein said caller is associated with telephone set, said payment server being adapted to determine said account from said telephone set (C5, 1-5-15 teaches determination of calling phone number/set and billing account accordingly).

As per claim 15, Gruchala teaches claim 6, further comprising a text transcriber station for manually transcribing vocal messages from the caller into digital messages.

Checco teaches analog voice messages are converted into digital information using standard analog-to-digital conversion. The voice PARS 408A may have, for example, an analog-to-digital converter for converting the analog voice message into a digital message suitable for storage on the voice and data messages storage 412. For example, a subscriber may have a preference to receive messages in e-mail format. The data messaging system may receive a message for the subscriber in any format for which a PARS is present. When the system determines that the message is for a particular subscriber, the subscriber's preferences (which may be stored, for example, in the voice and data message store 412) may be determined and the message may be converted into a preferred format. Alternatively, the message may be stored in the original format and be converted if necessary during upload in a manner described below (C9, L29-47).

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that the page includes caller information AND return request is used for auto-link connection AND voice message: can be digitized, to provide a system that automatically connects the calling/called parties AND provides a digitized

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voice message.

As per claim 16, Gruchala teaches claim 15, but is silent on wherein said paging server is adapted to send said digital messages to said pager. Gruchala teaches cell/paging systems which can transmit/receive digital messages (cellular can receive SMS messages).

Neustein teaches a paging system that provides caller information to the called party's display (C6, L32-43) which reads on transmission/reception of a digital message.

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that a digital message is sent, to provide means for both analog and digital messages to be supported by the system.

**Claims 17-26** rejected under 35 U.S.C. 103(a) as being unpatentable over Gruchala/Neustein/Foladare in view of Checco US 5,859,898.

As per claims 17 and 25, Gruchala teaches a cellular/paging system (ie. CPP or PPP) for sending a message to a subscriber of the system (title, abstract and figures 1-2) comprising:

Generating a page request by a caller, Receiving page request and generating a page which includes a number associated with said caller AND Transmitting said page to said pager/subscriber (abstract teaches paging party pays and figure 2 shows paging system - The examiner notes that Gruchala teaches Tandem/SCP/STP systems that perform paging operations as are known in the art).

**But is silent on**

Page includes information identifying caller,  
Receiving a return call request from the subscriber,  
Automatically establishing a voice channel between said subscriber and said caller in response to said return call request,  
generating a digital message by a human transcriber corresponding to said vocal message at said transcribing station.

Neustein teaches a paging system that provides caller information to the called party's display (C6, L32-43).

Foladare teaches return call request and connection between subscriber and caller via a bridging/signaling unit (abstract and figures 1 and 3a-3c). With further regard to claim 25, Gruchala teaches recording of a voice message (C4, L66 to C5, L4) but is silent on transcribing into a digital message and sending to user. Checco teaches analog voice messages are converted into digital information using standard analog-to-digital conversion (which can also include a human transcriber if said A-to-D converter is inoperative). The voice PARS 408A may have, for example, an analog-to-digital converter for converting the analog voice message into a digital message suitable for storage on the voice and data messages storage 412. For example, a subscriber may have a preference to receive messages in e-mail format. The data messaging system may receive a message for the subscriber in any format for which a PARS is present. When the system determines that the



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message is for a particular subscriber, the subscriber's preferences (which may be stored, for example, in the voice and data message store 412) may be determined and the message may be converted into a preferred format. Alternatively, the message may be stored in the original format and be converted if necessary during upload in a manner described below (C9, L29-47).

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that the page includes caller information AND return request is used for auto-link connection AND voice message: can be digitized, to provide a system that automatically connects the calling/called parties AND provides a digitized voice message.

As per claim 18, Gruchala teaches claim 17, wherein said caller is associated with a phone number and wherein said return request is generated by the subscriber by using a return call number different than said caller phone number.

As per claim 19, Gruchala teaches claim 17, but is silent on further comprises putting the caller on HOLD after said page request is generated and in response to return call request establishing said conference call between caller and subscriber by removing said hold.

Foladare teaches return call request, caller on HOLD and connection between subscriber and caller via a bridging/signaling unit (abstract and figures 1 and 3a-3c, Page 8 #328, #332, #336).

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that the caller is put on HOLD, to provide means for the called party to have time to call back the caller.

As per claim 20, Gruchala teaches claim 17 further comprising generating a charge for said page (C4, L15 to C5, L15 teaches multiple ways for the calling party to be charged. The examiner notes that if CPP/PPP is not enabled, the pager subscriber will always be charged) **but is silent on** based on a predetermined set of rules selected by the subscriber.

Gruchala teaches having the ability to bill calls based on the user's real-time preference. One skilled would also provide means for setting up beforehand how certain calls should be handled/billed (eg. abstract teaches predetermined rules).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Gruchala, such that there are predetermined rules, to provide means for the user to setup rules beforehand how certain calls are to be handled (rather than real-time).

As per claim 21, Gruchala teaches claim 17 further comprising generating a charge for said page and said return call (C4, L15 to C5, L15 teaches multiple ways for the caller to be billed OR called party to be billed, C3, L10-23).

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As per claim 22, Gruchala teaches claim 21 comprising obtaining a caller account associated with caller and applying said charge to said account (C4, L15 to C5, L15).

As per claims 23-24, Gruchala teaches claim 21 comprising providing a set of rules based on an identity of the callers and generating a charge based on said rules AND selecting a set of rules by the subscriber (C4, L15 to C5, L15).

As per claim 26, Gruchala teaches claim 26 **but is silent on** comprising said paging server sends a code with said vocal message to said transcription station and wherein said message includes code to identify the caller. Neustein teaches a paging system whereby the caller can be identified by a ID number or code (C6, L18-40).

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that the message includes a user ID code, to provide means for the called party to see the digitized voice message and know who sent it via the code.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta  
8-12-04



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